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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,343	08/01/2003	John B. Letts	P02030US2ABFDP	3593

7590 11/30/2009
John M. VasutaChief Intellectual Property Counsel
Bridgestone Americas Holding, Inc.
1200 Firestone Parkway
Akron, OH 44317

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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11/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,343

Applicant(s)

LETTS ET AL.

Examiner

John Cooney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,30-40,42-64 and 66-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,30-40,42-64 and 66-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Applicant's arguments filed 8-24-09 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 30-40, 42-64 and 66-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' originally filed supporting disclosure does not provide support for the expansion operations of the claims as they are now expressed differentiating between the various expansion agents identified by the claims.

This is a new matter rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, and 30, 31, 34-36, 46, and 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Raynor et al.(3,882,052).

Raynor et al. discloses preparations of isocyanate-based rigid foams prepared by contacting streams of isocyanate component and a polyol component wherein contacting takes place in the presence of blowing agent and inert gas, including nitrogen and air, to enhance the foaming action in amounts and to degrees sufficient to meet the requirements of applicants' claims (see the entire document). Further, Raynor et al. discloses room conditions or moderate heat which meet the temperature conditions of the claims.

As Raynor et al. provides for amounts of isocyanate being used in excess of isocyanate reactive component (see column 3 lines 13-17) difference based on applicants' recitation of "isocyanurate" in the preamble is not seen. This recitation in the preamble only requires that one isocyanurate linkage be present, and Raynor et al.'s disclosure of index values which provide for such linkages meets this requirement of the claims.

As to the amounts of inert gas required to meet the limitations of applicants' claims, Raynor et al.(see column 4 lines 15-32) provides for specific inclusion of these gases(column 4 line 5) in the embodiments of its disclosure. It is seen these amounts provided in the compositions of Raynor et al. and expelled under the pressure conditions of Raynor et al. would inherently result in the methods having inert gas

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contained in the compositions to be expelled that would inherently possess the dissolved gas concentration values of applicants' claims and inherently exhibit the expansion effects defined by applicants' claims upon expulsion from the mixer.

Difference is not seen between the amounts of gas disclosed and provided for by the teachings of Raynor et al. and those of applicants' claims based on the current evidence of record.

Applicants' arguments have been considered. However, rejection is maintained.

The following previous arguments are maintained:

It is held and maintained that Raynor et al. (column 4 lines 15-32) provides amounts which would be sufficient to impart this effect in systems under appropriate conditions. It is maintained that the ranges of amount values defined by the claims are inherent to the teachings of Raynor et al.

Additionally, though it is maintained that applicants' claim limitation mentioned above only pertains to amounts of gas employed, it is noted that though Raynor et al. desires no substantial pre-expansion (column 5 lines 50-65), it does not fully exclude some pre-expansion and through its language "no substantial pre-expansion", and, further, the disclosure of Raynor et al. indicates that "the foaming reaction commences practically as soon as the mixture is deposited" which encompasses the conditions defined by the claims.

As to applicants' latest arguments against the position that Raynor et al. inherently teaches the expansion degrees of applicants' claims, it is held that applicants have not demonstrated any difference between the compositional make-up and/or the processing features of their claims so as to make evident difference over the teachings of Raynor et al. in the patentable sense. As the Office is not in a position to run experiments to determine what degree of expansion is immediate versus later than immediate to determine if the expansion as defined by applicants' claims is met, it is held and maintained that burden is upon applicants to demonstrate differences evident in the processes based on the compositional make-up and/or processing features of their claimed invention.

Applicants' latest arguments have been considered. However, rejection is maintained. In that no difference is seen between the compositional make-ups and the actual process operations of applicants' claims and the make-ups and process operations of Raynor et al., it is maintained that inherency is evident. Though applicants' assert that difference is evident based on the amounts of inert gases employed, it is held and maintained that applicants' have not demonstrated a difference in their invention based on amounts of gas employed over the amounts allowed for by the teachings of Raynor et al. That Raynor et al. does not specifically describe their expansion as described by applicants does not negate that such expansion behavior is inherent to the teachings of Raynor et al. The Office is not in a position to run experiments to verify that specific behaviors are possessed by a referenced teaching. Therefore, burden is upon applicants to demonstrate where difference resides in the physical make-up of materials and/or process operations of their claimed invention.

Claims 34 and 51 are rejected under 35 U.S.C. 102(b) as being anticipated by Wishneski et al.(5,264,464).

Wishneski et al. discloses preparations of isocyanate-based rigid foams prepared by contacting streams of isocyanate component and a polyol component wherein contacting takes place in the presence of blowing agent and nitrogen gas to enhance

the foaming action in amounts and to degrees sufficient to meet the requirements of applicants' claims (see the entire document).

As Wishneski et al. provides for amounts of isocyanate being used in excess of isocyanate reactive component (see column 3 lines 12-14) difference based on applicants' recitation of "isocyanurate" in the preamble is not seen. This recitation in the preamble only requires that one isocyanurate linkage be present, and Wishneski et al.'s disclosure of index values which provide for such linkages meets this requirement of the claims.

As to the amounts of nitrogen required to meet the limitations of applicants' claims, Wishneski et al.(see column 7 lines 16-41) provides for specific inclusion of nitrogen in the embodiments of its disclosure. It is seen these amounts provided in the compositions of Wishneski et al. and expelled under the pressure conditions of Wishneski et al. would inherently result in the methods having nitrogen contained in the compositions to be expelled that would inherently possess the dissolved nitrogen concentration values of applicants' claims and inherently exhibit the expansion effects defined by applicants' claims upon expulsion from the mixer. Difference is not seen between the amounts of nitrogen disclosed and provided for by the teachings of Wishneski et al. and those of applicants' claims based on the current evidence of record.

Applicants' arguments have been considered. However, rejection is maintained.

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The following previous arguments are maintained:

It is held and maintained that Wishneski et al. provides amounts which would be sufficient to impart this effect in systems under appropriate conditions, including the accompanying employment of the blowing/frothing agent disclosed in Wishneski et al. It is maintained that the ranges of amount values defined by the claims are inherent to the teachings of Wishneski et al.

Further, as to applicants' arguments specific to Wishneski et al at column 7 lines 37-41, it is held that it is clear from Wishneski et al. (see abstract, column 1 lines 25-42) that it is the need for an auxiliary CFC foaming agent is the result which is being avoided. Wishneski et al. is clear in its employment of frothing agents and formation of frothed foams (column 1 line 37-55 and column 8 line 36). Distinction based on this feature is not evident.

As to applicants' latest arguments against the position that Wishneski et al. inherently teaches the expansion degrees of applicants' claims, it is held that applicants have not demonstrated any difference between the compositional make-up and/or the processing features of their claims so as to make evident difference over the teachings of Wishneski et al. in the patentable sense. As the Office is not in a position to run experiments to determine what degree of expansion is immediate versus later than immediate to determine if the expansion as defined by applicants' claims is met, it is held and maintained that burden is upon applicants to demonstrate differences evident in the processes based on the compositional make-up and/or processing features of their claimed invention. It is maintained as stated above that Wishneski et al. provides amounts which would be sufficient to impart the effects recited in applicants' claims, including the accompanying employment of the blowing/frothing agent disclosed in Wishneski et al. It is maintained that the ranges of amount values defined by the claims are inherent to the teachings of Wishneski et al.

Applicants' latest arguments have been considered. However, rejection is maintained. In that no difference is seen between the compositional make-ups and the actual process operations of applicants' claims and the make-ups and process operations of Wishneski et al., it is maintained that inherency is evident. Though applicants' assert that difference is evident based on the amounts of inert gases employed, it is held and maintained that applicants' have not demonstrated a difference in their invention based on amounts of gas employed over the amounts allowed for by

the teachings of Wishneski et al. That Wishneski et al. does not specifically describe their expansion as described by applicants does not negate that such expansion behavior is inherent to the teachings of Wishneski et al. The Office is not in a position to run experiments to verify that specific behaviors are possessed by a referenced teaching. Therefore, burden is upon applicants to demonstrate where difference resides in the physical make-up of materials and/or process operations of their claimed invention.

The previous rejections under 35 USC 112 2nd paragraph and 35 USC 103 are withdrawn in light of applicants' amendments, but these grounds of rejection will need to be reinstated and/or reconsidered for reinstatement when the new matter is removed from the claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1796